

ESTTA Tracking number: **ESTTA767913**

Filing date: **08/31/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Pacific Metrics Corporation
Granted to Date of previous extension	08/31/2016
Address	1 Lower Ragsdale Drive Building 1 Suite 150 Monterey, CA 93940 UNITED STATES
Attorney information	LEO M. LOUGHLIN Rothwell, Figg, Ernst & Manbeck, pc 607 14th Street NW Suite 800 Washington, DC 20005 UNITED STATES PTO-TM-Email@rfem.com Phone:202-783-6040

Applicant Information

Application No	86620173	Publication date	05/03/2016
Opposition Filing Date	08/31/2016	Opposition Period Ends	08/31/2016
Applicant	Motivis Learning Systems, Inc. Suite 204 Salem, NH 03079 UNITED STATES		

Goods/Services Affected by Opposition


Class 042. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Software as a Service (SAAS) services featuring social networking software for building and managing online communities in K-12 and higher education institutions among students and prospective students, parents, faculty, staff and alumni that features a customizable homepage, news stories, discussion boards, notifications, one-to-one messaging, group messaging, user profiles, feeds, user connecting and following, interests with themes and tags, searching of content within the SaaS service, listing and management of groups, listing and management of events, and listing and management of resources for users related to their experience at the institution
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	4969188	Application Date	01/17/2014
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Registration Date	05/31/2016	Foreign Priority Date	NONE
Word Mark	UNITY		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 2015/10/02 First Use In Commerce: 2015/10/02 Computer software which provides a web-based application to create and administer educational tests via mobile, handheld or traditional desktop computers</p> <p>Class 042. First use: First Use: 2015/10/02 First Use In Commerce: 2015/10/02 Providing an online non-downloadable web-based application to create and administer educational tests for grades K-12 and above, intended to measure student learning across multiple disciplines including but not limited to: mathematics, English, science, history and social studies for tests which include both in-classroom formative assessments and higher stakes summative assessments</p>		

Attachments	86168503#TMSN.png(bytes) 3407-136Opp.pdf(798198 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Leo M. Loughlin/
Name	LEO M. LOUGHLIN
Date	08/31/2016

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application
Serial No. 86/620173
Published on May 3, 2016

Pacific Metrics Corporation)	
)	
Opposer.)	Opposition No. _____
)	
v.)	
)	
Motivis Learning Systems, Inc.)	
)	
Applicant.)	

TRADEMARK TRIAL AND APPEAL BOARD
Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22312-1451

NOTICE OF OPPOSITION

Opposer, Pacific Metrics Corporation (“Pacific Metrics”), with an address at 1 Lower Ragsdale Drive, Building 1, Suite 150, Monterey, California 93940, a corporation organized under the laws of California, believes that it will be damaged by the registration of the mark UNITY (hereinafter “Applicant’s Mark”) which is owned by Motivis Learning Systems, Inc. (“Motivis”) with an address at 25 Pelham Road, Suite 204, Salem, New Hampshire 03079, a corporation organized under the laws of Delaware (hereinafter “Applicant”) for “software as a Service (SAAS) services featuring social networking software for building and managing online communities in K-12 and higher education institutions among students and prospective students, parents, faculty, staff and alumni that features a customizable homepage, news stories, discussion boards, notifications, one-to-one messaging, group messaging, user profiles, feeds, user connecting and following, interests with themes and tags, searching of content within the SaaS

services featuring social networking software for building and managing online communities in K-12 and higher education institutions among students and prospective students, parents, faculty, staff and alumni that features a customizable homepage, news stories, discussion boards, notifications, one-to-one messaging, group messaging, user profiles, feeds, user connecting and following, interests with themes and tags, searching of content within the SaaS service, listing and management of groups, listing and management of events, and listing and management of resources for users related to their experience at the institution,” in Class 42 and the application is based on 1(b) (intent to use).

5. Pacific Metrics' use, as early as 2013 of its UNITY Mark in the U.S. predates Applicant's filing of U.S. Application Serial No. 86/620,173, filed on May 5, 2015.

6. Applicant's Mark is *identical* to Pacific Metrics' UNITY Mark.

7. The services listed in U.S. Application Serial No. 86/620,173 are nearly identical to the goods/services offered by Pacific Metrics under its UNITY Mark. Indeed, both Pacific Metrics and Applicant's advertise their products as a personalized learning platform, the customers and users of both Pacific Metrics and the Applicant's product are likely to be confused, including the following: (a) Higher education students, teachers and educational administrators; (b) K-12 students, teachers and educational administrators; (c) schools, school districts, and state departments of education; and (d) procurement personnel within state organizations who are responsible for purchasing higher education and K-12 educational products.

8. Upon information and belief, Applicant's platform under Applicant's Mark appears to have been released as either open source or a free version and third parties are using it

in connection with student measurement for K-12 education, identical to the services offered by Pacific Metrics under its UNITY Mark.

9. Upon information and belief, Applicant's Unity product is currently being used for K-12 education which is the exact same audience for which Pacific Metrics' UNITY product is targeted. An example of Applicant's use of UNITY for K-12 education is attached as **Exhibit A-2**.

10. Applicant's Mark is identical to Pacific Metrics previously used and registered UNITY Mark that its use, in connection with the services aforementioned, is likely to cause confusion, or to cause mistake or deceive, in violation of Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052 (d).

11. Purchasers of Applicant's products likely will assume that Pacific Metrics is somehow affiliated with, licenses, or endorses, Applicant's use of Applicant's Mark when Pacific Metrics is not connected in any way with Applicant or the use of Applicant's Mark. Thus, Applicant's use of Applicant's Mark will damage Pacific Metrics and the public.

12. Applicant is not affiliated or connected with or endorsed or sponsored by Pacific Metrics, nor has Pacific Metrics approved any of the services offered by Applicant under Applicant's Mark, nor has Pacific Metrics granted Applicant permission to use said mark.

13. The registration of the Applicant's Mark will be inconsistent with Pacific Metrics' rights in the UNITY Mark, the registration pleaded above and Pacific Metrics' rights at common law and will be damaging to Pacific Metrics.

14. Use and registration of Applicant's Mark will deprive Pacific Metrics of the ability to protect its reputation and goodwill.

WHEREFORE, Pacific Metrics prays that this opposition be sustained and registration on Application Serial No. 86/620,173 be refused.

Respectfully submitted,

Pacific Metrics Corporation

By:



Steven Lieberman

Leo M. Loughlin

Attorneys for Opposer

Rothwell, Figg, Ernst & Manbeck P.C.

607 14th Street, N.W.

8th Floor

Washington, DC 20005

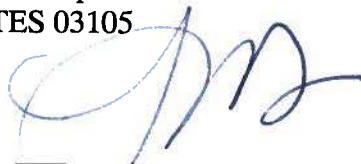
Phone: 202-783-6040

Date: August 31, 2016

CERTIFICATE OF SERVICE

This is to certify that on August 31, 2016, a copy of the foregoing NOTICE OF OPPOSITION and **Exhibits A-1 through A-2** have been served via First Class Mail, postage prepaid, to the following:

DOUGLAS G. VERGE
Sheehan Phinney Bass Green Pa
P.O. Box 3701
1000 Elm St
Manchester, New Hampshire
UNITED STATES 03105



Lisa M. Locke

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Mark: UNITY

UNITY

US Serial Number: 86168503

Application Filing Date: Jan. 17, 2014

US Registration Number: 4969188

Registration Date: May 31, 2016

Register: Principal

Mark Type: Trademark, Service Mark

Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: May 31, 2016

Publication Date: Jan. 06, 2015

Notice of Allowance Date: Mar. 03, 2015

Mark Information

Mark Literal Elements: UNITY

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis (()) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks "*" identify additional (new) wording in the goods/services.

For: Computer software which provides a web-based application to create and administer educational tests via mobile, handheld or traditional desktop computers

International Class(es): 009 - Primary Class

U.S Class(es): 021, 023, 026, 036, 038

Class Status: ACTIVE

Basis: 1(a)

First Use: Oct. 02, 2015

Use in Commerce: Oct. 02, 2015

For: Providing an online non-downloadable web-based application to create and administer educational tests for grades K-12 and above, intended to measure student learning across multiple disciplines including but not limited to: mathematics, English, science, history and social studies for tests which include both in-classroom formative assessments and higher stakes summative assessments

International Class(es): 042 - Primary Class

U.S Class(es): 100, 101

Class Status: ACTIVE

Basis: 1(a)

First Use: Oct. 02, 2015

Use in Commerce: Oct. 02, 2015

Basis Information (Case Level)

Filed Use: No

Currently Use: Yes

Amended Use: No

Filed ITU: Yes

Currently ITU: No

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: Pacific Metrics Corporation

Owner Address: 1 Lower Ragsdale Drive
Building 1, Suite 150
Monterey, CALIFORNIA 93940
UNITED STATES

Legal Entity Type: CORPORATION

State or Country CALIFORNIA
Where Organized:

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Steven Lieberman

Docket Number: 3407-130

Correspondent

Correspondent Name/Address: STEVEN LIEBERMAN
ROTHWELL, FIGG, ERNST & MANBECK, PC
607 14TH ST NW STE 800
WASHINGTON, DISTRICT OF COLUMBIA 20005-2005
UNITED STATES

Phone: 202-783-6040

Fax: 202-783-6031

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
May 31, 2016	REGISTERED-PRINCIPAL REGISTER	
Apr. 28, 2016	NOTICE OF ACCEPTANCE OF STATEMENT OF USE MAILED	
Apr. 27, 2016	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Apr. 08, 2016	STATEMENT OF USE PROCESSING COMPLETE	66230
Mar. 03, 2016	USE AMENDMENT FILED	66230
Apr. 06, 2016	CASE ASSIGNED TO INTENT TO USE PARALEGAL	66230
Mar. 03, 2016	TEAS STATEMENT OF USE RECEIVED	
Sep. 04, 2015	NOTICE OF APPROVAL OF EXTENSION REQUEST MAILED	
Sep. 02, 2015	EXTENSION 1 GRANTED	98765
Sep. 02, 2015	EXTENSION 1 FILED	98765
Sep. 02, 2015	TEAS EXTENSION RECEIVED	
Mar. 03, 2015	NOA MAILED - SOU REQUIRED FROM APPLICANT	
Jan. 06, 2015	PUBLISHED FOR OPPOSITION	
Dec. 17, 2014	NOTICE OF PUBLICATION	
Dec. 01, 2014	LAW OFFICE PUBLICATION REVIEW COMPLETED	70138
Dec. 01, 2014	ASSIGNED TO LIE	70138
Nov. 12, 2014	APPROVED FOR PUB - PRINCIPAL REGISTER	
Nov. 12, 2014	EXAMINERS AMENDMENT MAILED	
Nov. 12, 2014	EXAMINER'S AMENDMENT ENTERED	88888
Nov. 12, 2014	EXAMINERS AMENDMENT -WRITTEN	62920
Nov. 06, 2014	FINAL REFUSAL MAILED	
Nov. 06, 2014	FINAL REFUSAL WRITTEN	62920
Oct. 20, 2014	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Oct. 20, 2014	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Oct. 20, 2014	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Apr. 23, 2014	NON-FINAL ACTION MAILED	
Apr. 22, 2014	NON-FINAL ACTION WRITTEN	62920
Apr. 22, 2014	ASSIGNED TO EXAMINER	62920
Jan. 30, 2014	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Jan. 21, 2014	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Apr. 27, 2016

UNITY

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Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

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Owner Address: 1 Lower Ragsdale Drive
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State or Country CALIFORNIA
Where Organized:

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Attorney of Record

Attorney Name: Steven Lieberman**Docket Number:** 3407-130

Correspondent

Correspondent Name/Address: STEVEN LIEBERMAN
ROTHWELL, FIGG, ERNST & MANBECK, PC
607 14TH ST NW STE 800
WASHINGTON, DISTRICT OF COLUMBIA 20005-2005
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Phone: 202-783-6040**Fax:** 202-783-6031**Domestic Representative - Not Found**

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TM Staff Information - None

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